

REMARKS

This paper is submitted in response to the Office Action dated August 16, 2007. Claims 1-2 were previously cancelled, no claims have been amended, and no new claims have been entered. Thus, claims 3-32 remain pending in the application.

The Examiner rejected claims 3-32 under 35 U.S.C. 102(b) as being anticipated by Harrell et al. (U.S. Pub. No. 2002/0016727). Applicant respectfully traverses that rejection and request reconsideration and withdrawal of same.

First and most importantly, a *prima facie* case of anticipation has not been made. Clearly, it is the Office's initial duty to supply the factual basis supporting a rejection of a patent application, including a rejection based upon anticipation. *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967), *cert denied*, 389 U.S. 1057 (1968). This initial duty places on the Commissioner and on the Examiner the burden of presenting a *prima facie* case of anticipation. *See In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). Any anticipation analysis must be "conducted on a limitation by limitation basis, *with specific fact findings for each contested limitation and satisfactory explanations for such findings.*" *Gechter v. Davidson*, 116 F.3d 1454, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (emphasis added).

In this case, the Examiner has failed to provide any explanation of how Harrell et al. allegedly disclose the specific claim elements in any of Applicant's claims. For instance, in the rejection of claim 3, the Examiner broadly points to 297 lines in 15 paragraphs of the published application, without a single specific reference to any element in the reference that allegedly discloses any aspect of Applicant's claimed invention. Nowhere does the Examiner provide specific fact findings for any claim limitation or any explanation for any such findings. The office action thus leaves the Applicant to guess specifically where in the reference and what

specific elements in the reference allegedly disclose the distinct elements in Applicant's claims. Requiring the Applicant to guess as to the basis of the Examiner's rejection is clearly improper and fails to establish a *prima facie* case of anticipation.

It is well established that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.)).

Moreover, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann*

Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed.

Cir. 1983)). To properly determine whether a reference anticipates, "the trier of fact must

identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Id.* at 485. Here, the Examiner has made sweeping reference to large portions of

Harrell et al. without any explanation of how any portion of those sweeping citations particularly disclose Applicant's claimed invention, and it is far less than self evident of how the Examiner would support such allegation. In fact, the Examiner has not made a single reference to any specific element or elements in the prior art reference. Having failed to provide any specific indication of how or where each and every element of Applicant's claims are disclosed in Harrell et al., the Examiner has failed to establish a *prima facie* case of anticipation, and the rejection under 35 U.S.C. 102(b) should be withdrawn.

Moreover, it is respectfully submitted that because the Examiner has failed to make a *prima facie* case of anticipation, any office action that follows this response should not be made final, as Applicant has not yet had opportunity to consider and respond to a proper rejection.

Notwithstanding the Examiner's failure to present a *prima facie* case of anticipation, in an effort to further prosecution of the application, Applicant will herein highlight some basic features that readily distinguish Harrell et al. from Applicant's independent claims. First, Applicant's claimed invention describes a community in which all community members (the claimed users) may create and edit their own user data files, add those data files to a single collection, and search that single collection of user data files of all users. As all of the user data files are stored as a single collection, they are thus searchable by all users in order determine whether other user data files exist having the claimed predefined relationship with the searching user's file. The claim defines such a single collection of user data files, and searching within that collection of user data files to find relationships between them. Such an open but nonetheless single community approach of seeking business development opportunities provides significantly improved likelihood that separate entities (who might not initially realize that a potential valuable business relationship exists) will find unexpected connections between their user data file and those of other users, thus warranting further exploration of a potential business relationship. In contrast, the reference describes multi-tiered, security protected innovation profiles assembled into a collection of searchable innovation profiles, and developer profiles assembled into a separate collection of developer profiles. Innovators can search developer profiles and developers can search, to a limited extent, innovator profiles. This system does not disclose a single collection that is searchable by all members of the group of users that generate that collection. In other words, the Examiner has nowhere indicated, nor has the Applicant found

after review of the reference, any disclosure indicating that innovators would search innovator profiles of other innovators, or any disclosure indicating that developers would search developer profiles of other developers, to find connections amongst themselves.

In fact, it is an important feature of the invention described in the instant application that the user data file be a single, standardized format (paragraph 0048 of Applicant's published application), as such standardized format ensures that each member of the collective group of users uses the same qualitative and quantitative criteria to describe their business so that accurate models of potential business development transactions can be produced and compared on a standardized basis. It is this normalization of the business development process that streamlines the process, replacing months of back-and-forth exploratory discussions required by prior known business development processes. See paragraph 0048 of the instant specification. In contrast, Harrell et al. require separate collections of innovator profiles and developer profiles, and in fact maintain segments of the innovator profiles that describe the innovator's product or service in secret from the developer users (precisely opposite the instant invention).

With regard to automatically finding stored data files having a predefined relationship with the user's own data file (which relationship comprises a correlation between market segments), such feature is nowhere indicated in the Examiner's broad citation of paragraphs 0007 and 0034. Moreover, having made a diligent search of the reference for each mention of the term "market" in an effort to guess where the Examiner considers this feature to be disclosed, Applicant has found none. However, the most telling reference to use of a "market" factor by Harrell et al. is in paragraph 0055, where it recites "[a]s illustrated by block 110, if the *developer* determines that a particular innovation profile fits the type of innovation and/or market opportunity that the developer is seeking, the developer may request disclosure of the level-two

innovation profile for that innovation” (emphasis added). Clearly, Harrell et al. do not envisage a library of market segment relationships, much less an automated tool for retrieving records of other users that have related or complementary, but not identical, market segments. The advantage that such feature offers the invention is that the user need not know what market their own product or service might be complementary to; rather, the automated tools and the market space taxonomic library present to the user products or services of other users that, in accordance with such taxonomy, bear a complementary relationship to the market segment or segments of the user’s own product or service. This results in far greater opportunities being presented to the user than if they had to manually search for records of others having only those market designations that the user can think of as being possibly complementary, as is required by the reference.

Next, the Examiner cites a full 10 paragraphs (184 lines of text from Applicant’s published specification) alleging that such lengthy discussion discloses Applicant’s claimed mating function. Once again, Applicant finds nowhere that Harrell et al. make such disclosure. Assuming that the Examiner believes that the innovator profiles and the developer profiles of Harrell et al. meet Applicant’s claim limitation of a user data file, nowhere does Harrell et al. disclose combining elements of separate innovator profiles and other innovator profiles or developer profiles, much less combining such combined data with yet additional data describing a hypothetical new business development transaction, as specifically required by Applicant’s claims.

Last, the Examiner cites paragraph 0030 as alleging disclosing Applicant’s claimed construction of a financial model of such new business development transaction, but again the referenced paragraph nowhere makes such disclosure.

As each of these limitations is present in each of Applicant's claims, all of the pending claims are patentably distinguished. Applicant therefore respectfully requests that the rejection of claims 3-32 under 35 U.S.C. 102(b) be withdrawn.

Applicant further notes that claim 19 (and thus claims 20 – 25 depending therefrom) includes limitations that the Examiner has not addressed at all in the office action, specifically:

(i) a plurality of database records accessible to said server computer and comprising said stored data files;

(ii) a plurality of database records accessible to said server computer and comprising said predetermined relationships among market segments; and

(iii) a plurality of database records accessible to said server computer and comprising financial variables and equations for producing said financial model of said hypothetical business development transaction.

Once again, lacking these elements, it is believed that Harrell et al. do not show "each and every element of the claimed invention, arranged as in the claim," *Lindemann Maschinenfabrik GmbH* at 485, as is required in order to support an anticipation rejection. For these reasons, claims 19-25 are even further patentably distinguished. Moreover, as these elements have not yet been considered at all by the Examiner, any office action that follows this response should not be made final, as applicant has not yet had opportunity to consider and respond to a proper rejection.

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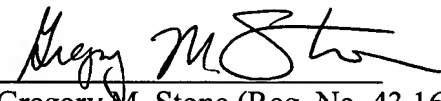
In light of the above amendments and remarks, it is believed that all claims are in proper condition for allowance, and a notice in that regard is respectfully requested. If any further

issues need be addressed prior to allowance, Applicant respectfully requests that the undersigned be contacted via telephone so that such further issues can be promptly addressed.

If any fees are due in connection with the filing of this Response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to our Deposit Account No. 50-1479. If an extension of time under 37 C.F.R. § 1.136 is necessary and not accounted for in the papers filed herewith, such an extension is requested. The extension fee should also be charged to Deposit Account No. 50-1479.

Respectfully submitted,

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Date


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